

REMARKS

Upon entry of this Amendment, claims 1-18 are all the claims pending in the application. Claims 9-18 have been added. Claims 1-8 presently stand rejected.

The drawings filed November 13, 2001 are objected to by the Examiner; specifically, FIG. 9 has a typographical error, and the Examiner has suggested that FIGS. 1 and 2 should be designated with the legend --Prior Art-- because only that which is old is illustrated. In response, it is noted that Applicants filed the Submission of Formal Drawings on January 25, 2002, in which FIG. 9 was submitted without the typographical error.

Applicants have submitted herewith replacement drawings for FIGS. 1 and 2, in which the legend --PRIOR ART-- has been added. The Examiner's is respectfully requested to acknowledge receipt of the drawings filed on January 25, 2002. Additionally, withdrawal of the drawing objection of FIGS. 1, 2 and 9 are, thus, kindly requested.

The Examiner has objected to the title of the invention as not being descriptive. In response, Applicants have amended the title. Withdrawal of the objection is kindly requested.

In regard to the claim rejections, claims 1-3 are rejected under 35 U.S.C. § 112, second paragraph, and claims 4 and 5 are rejected because they are dependent upon base claim 1; Applicants thank the Examiner for acknowledging that claim 4 would, however, be allowable if rewritten to overcome the § 112, second paragraph, rejection, and if rewritten in independent form.

Claims 1-3 and 6-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yoshida et al. (EP 1107058 A2); and

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshida et al. (EP 1107058 A2) in view of Usami et al. (USP 5,274,623).

For the reasons set forth below, Applicants respectfully traverse the rejections and requests favorable disposition of the application.

Argument

In regard to the rejection of claims 1-5 under 35 U.S.C. § 112, second paragraph, Applicants have amended independent claims 1-3 to remove reference to “the read signal”. Applicants submit that all claims satisfy the requirements of 35 U.S.C. § 112 and, accordingly, withdrawal of the rejection is in order.

In regard to the rejection of claims 1-3 and 6-8 under 35 U.S.C. § 102(b) as being anticipated by Yoshida et al. (EP 1107058 A2), Applicants respectfully submit that Yoshida et al. fails to teach or otherwise suggest at least the position identifying portion explicitly recited in each of independent claims 1-3 and 6-8. In particular, claims 1-3 and 6-8 each recite, *inter alia*, a position identifying portion for identifying the position of a control data recording area where control data regarding recording of said information data signal is recorded. Similarly, claims 6-8 each recite identifying the position of a control data recording area where control data regarding recording of said information data signal is recorded. Yoshida et al. does not disclose the identification of the position of a control data recording area as claimed.

As disclosed, for example, at page 10, line 17 through page 12, line 18 of the present specification, the position of the control data recording area is used to enable writing to the extra border zone of the recording medium. The grounds of rejection assert that this feature, for

example, the position identifying portion, is disclosed in Yoshida et al. by the “pre-pit detector” 11 shown in FIG. 3. (Office Action, page 3, par. No. 10). Applicants submit, however, that the pre-pit detector of Yoshida et al. does not identify the position of a control data recording area of an optical recording medium, as claimed. More particularly, at paragraph number [0063], Yoshida et al. discloses that “[t]he prepit detector 11 extracts a signal corresponding to the prepits 4 from the detection signal Sp by the radial push-pull method, and outputs the same to the timing generator 12 and the prepit decoder 17 as a prepit signal Spp.” Nowhere in Yoshida et al. is it disclosed, either implicitly or explicitly, that the prepit detector 11 identifies the position of a control data recording area where control data regarding recording of an information data signal is recorded.

For at least the above reason, Yoshida et al. does not anticipate any of claims 1-3 and 6-8 of the present application and, thus, the rejection under 35 U.S.C. §102 against these claims should be withdrawn.

Usami et al. fails to compensate for the above described deficiency in Yoshida et al. and, accordingly, for at least the same reason as described above, the proposed combination of Yoshida et al. and Usami et al. does not render claim 5, which depends from claim 1, obvious. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103 against claim 5 be withdrawn.

Patentability of New Claims

For additional claim coverage merited by the scope of the invention, Applicants have added new claims 9-18. Applicants submit that the prior art does not disclose, teach, or

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/987,085


otherwise suggest the combination of features contained therein. For example, none of the prior art references teach or otherwise suggest a controller operable to determine the position of a control data zone on the recording medium, wherein the control data zone stores data regarding recording of the recording information. Support for the subject matter recited in new claims 9-11 is found at least at page 11, lines 5-22 of the original application. New claims 12-18 are patentable at least by virtue of their dependency from independent claims 1 or 6, which are allowable for at least the reason discussed above.

Conclusion

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims **1-18**, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Kevin M. Barner
Registration No. 46,075

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 13, 2004

Attorney Docket No.: Q67159